

REMARKS

The Office Action of May 14, 2008 was received and carefully reviewed. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1-19 were pending prior to the instant amendment. By this amendment, claims 1-8 are amended. Consequently, claims 1-19 are currently pending in the instant application with claims 1-8 being independent.

Initially, Applicants note that the "Written Opinion of the International Searching Authority for PCT/JP2004/018073" was not indicated as considered in the Information Disclosure Statement (PTO-1449) filed May 3, 2006. Therefore, Applicants respectfully request that the Examiner consider the same.

In the Office Action, claims 7 and 8 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention due to a lack of antecedent basis. In response, Applicants have amended claims 7 and 8 to read --the pair of third conductive layers-- instead. Therefore, Applicants respectfully request that the 112 rejection be removed.

Additionally, claims 1-4, 10, 18 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. Pub. 2002/0089616 to Hashimoto et al. (Hashimoto).

Hashimoto, however, fails to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. For example, amended independent claims 1-4 recite a combination that includes, among other things:

a second conductive layer on and in contact with the insulating layer and the first conductive layer.

At the very least, Hashimoto fails to disclose or suggest any of these exemplary features recited in the independent claims 1-4.

To establish anticipation under 35 U.S.C. § 102(b), the Examiner must show that each and every feature recited in these claims is either explicitly disclosed or “necessarily present” in a single prior art reference, such as within the four corners of the Hashimoto patent. *See* M.P.E.P. § 2131(7th ed. 1998); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). To support a conclusion of anticipation, the Examiner must specifically identify “substantial evidence” setting forth why and how the single prior art reference anticipates each and every feature recited in the claims. *See In re Mullin*, 481 F.2d 1333, 1336-37 (CCPA 1973) (An Examiner’s bare assertion that claims were obviously anticipated by a reference did not inform the Applicant as to why the claims lacked novelty); *Dickinson v. Zurko*, 527, U.S. 150 (1999) (The U.S. Patent Office’s findings of fact must be reviewed by the substantial evidence standard).

Viewed against this backdrop, each of the Examiner’s factual conclusions must be supported by “substantial evidence” in the documentary record. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness “less to ‘haze of so-called expertise’ acquire insulation from accountability.” *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b). In this case, however, the Examiner cannot satisfy his burden of demonstrating how Hashimoto, taken alone or in combination with any other prior

art reference, can either render obvious each and every one of the limitations present in independent claims 1-4 as required by the Manual of Patent Examining Procedure (“MPEP”) and Federal Circuit jurisprudence.

With respect to independent claims 1 and 2, the Examiner asserts that Hashimoto “discloses in figure 5, a thin film transistor comprising: an insulating layer (see Fig. 5) having a first opening; a first conductive layer 12B in the first opening; a second conductive layer 4M on the first insulating layer and the first conductive layer 12B; wherein the first conductive layer 12B is wider and thicker than the second conductive layer 4M.”

However, as shown above, Applicants have amended claims 1-4 to recite, *inter alia*, the features a second conductive layer (104) on and in contact with the insulating layer (102b) and the first conductive layer (103). (See, for example, as shown in FIG. 18A). On the other hand, it appears that Hashimoto fails to teach or disclose the features of a second conductive layer on and in contact with the insulating layer and the first conductive layer, as presently claimed.

Further, with respect to independent claims 3 and 4, the Examiner asserts that a second conductive layer of the present invention corresponds to 71 in FIG. 5 of Hashimoto. However, it appears that 71 is not a conductive layer but LDD regions of a semiconductor film. (See paragraph [0003] of Hashimoto). Therefore, Applicants contend that the rejection is not proper.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claims are not found either expressly or inherently described as required by the M.P.E.P., Hashimoto

cannot be said to anticipate the invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 5-7, 8 and 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of U.S. Patent No. 4,389,481 to Poleshuk et al. (Poleshuk); claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto as applied to claim 1 above, and in view of U.S. Patent No. 5,329,390 to Fujiwara et al. (Fujiwara); claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto as applied to claim 8 above, and in view of U.S. Pat. Pub. 2001/0014528 to Tsai (Tsai); claims 13 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto as applied to claim 8 above, and in view of U.S. Pat. Pub. 2001/0034088 to Nakamura et al. (Nakamura); and claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto as applied to claim 1 above, and in view of U.S. Patent No. 6,461,914 to Roberts et al. (Roberts). These rejections are traversed as discussed in detail below.

Hashimoto in view of Poleshuk, however, fails to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. For example, amended independent claims 5-8 recite a combination that includes, among other things:

a second conductive layer on and in contact with the insulating layer and the first conductive layer.

At the very least, the applied references, whether taken alone or in combination, fail to disclose or suggest any of these exemplary features recited in independent claims 4-8.

The Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated how Hasimoto and Poleshuk, whether

taken alone or in combination, disclose or suggest each and every feature recited in the claims. *See* M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner has not shown the existence of any reasonable probability of success in modifying Hashimoto, the base reference, based on the teachings of Poleshuk, the secondary reference, in a manner that could somehow result in the claimed invention. *See id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the apparatus of Hashimoto in a manner that could somehow result in the claimed invention. *See id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. *See id.*

Each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record, as required by the Federal Circuit. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Hashimoto, taken alone or in combination with Poleshuk, can either anticipate or render obvious each and every one of the limitations present in independent claims 4-8, as required by the M.P.E.P. and Federal Circuit jurisprudence.

The Examiner attempts to remedy the deficiencies of Hashimoto by turning to Poleshuk. Poleshuk discusses lists of electroluminescent material and liquid crystal material

as alternative materials used in image display devices. However, Poleshuk fails to disclose or suggest the features of a second conductive layer on and in contact with the insulating layer and the first conductive layer, as recited in claims 4-8.

The Examiner attempts further to remedy the deficiencies of Hashimoto by turning to Fujiwara, Tsai, Nakamura and/or Roberts. However, Fujiwara, Tsai, Nakamura and/or Roberts do not disclose or suggest the features of a second conductive layer on and in contact with the insulating layer and the first conductive layer, as recited in claims 4-8.

In addition, with respect to claims 7 and 8, the Examiner asserts that a second conductive layer of the present invention corresponds to 71 in FIG. 5 of Hashimoto. However, it appears that 71 is not a conductive layer but LDD regions of a semiconductor film. (See paragraph [0003] of Hashimoto). Therefore, Applicants contend that the rejection is not proper.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Hashimoto, Poleshuk, Fujiwara, Tsai, Nakamura nor Roberts taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 4-8. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 1, 2, 3, 4, 5, 6, 7 or 8 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 1-8.

In addition, each of the dependent claims also recites combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not anticipated or rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicants in no way intend to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned agent at (202) 585-8100.

Respectfully submitted,

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